

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 006119.00010)

In re U.S. Patent Application of Johnston,)	
et al.)	
)	Group Art Unit: 3624
Application No. 10/676,318)	
)	Examiner: Colbert
Filed: October 1, 2003)	
)	Confirmation No. 6511
For: Order Risk Management System)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box Appeal Briefs - Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-14501

Sir:

Applicants respectfully request review of the 2nd rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the Office Action dated November 16, 2005, the Applicant respectfully submits that the outstanding rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The outstanding 35 U.S.C. §112 rejection is clearly improper.

The Applicant believes the rejection to be improper and respectfully requests reconsideration and reversal.

Interview of January 29, 2007

Applicants would like to thank the Examiner for participating in the telephonic interview of January 29, 2007 with Applicants' representative. During the interview, Applicants' representative and Examiner discussed the objections to the title and abstract. Applicants agreed to change "system" to –method— in the title and to remove "Systems and" from the first line of the Abstract. As discussed, Applicants approve of these minor changes, which may be made by Examiner's Amendment or in the next Response.

During the interview, Applicants and Examiner also discussed the only outstanding rejection, which is a rejection under 35 USC § 112, 2nd paragraph. During the interview Applicants' representative described every claim limitation in claim 1, with reference to the drawings and specification, and attempted to show the Examiner how claim 1 complies with 35 USC § 112, 2nd paragraph. The Examiner indicated that she needs additional time to re-consider the claim language. The Examiner and Applicant did not reach an agreement regarding the rejection, but agreed that a pre-appeal brief would be appropriate.

Rejection under 35 USC § 112, 2nd paragraph

There are no prior art rejections outstanding in this case. The only outstanding rejection is a rejection under 35 USC § 112, 2nd paragraph.

On page 2 the Office Action suggests that claim 1 is "incomplete for omitting essential steps, such omission amounting to a gap between the steps." On page 3, the Office Action suggests that the "steps need to be connected to each other because otherwise there is a disconnect with the steps of the invention."

Claim 1 includes the following limitations:

A method of processing derivative product orders at an exchange, the method comprising:

- (a) receiving **derivative product order risk data**¹ including at least one threshold value corresponding to at least one order risk parameter;
- (b) receiving from a trader an **order for a derivative product**²;
- (c) utilizing **the derivative product order**² and a trader's current order risk utilization state to calculate **utilization data**³; and
- (d) processing the derivative product order in a manner that is a function of **the derivative product order risk data**¹ and **the utilization data**³.

Applicants respectfully submit that the 4 clauses ((a) through (d)) included in the claim are connected. For example, clause (c) refers to back to clause (b), and clause (d) refers back to both clauses (a) and (c). Each clause is at least explicitly linked to at least one other clause. Claim 1 does not include any clause that does not refer back to at least one other clause. Therefore, there are no steps missing in the claim.

The relevant claim elements have been highlighted and flagged with reference numbers to indicate how the clauses are linked. For example, in clause (a) “derivate product order risk data” is marked with reference number 1. Similar language in clause (d) is marked with the same reference number.

Even after the Examiner Interview on January 29, 2007, it remains unclear to Applicants how the claim could be considered to be “incomplete for omitting essential steps, such omission amounting to a gap between the steps.” The language provided in the Office Action at the bottom of page 2 and the top of page 3 adds to this confusion. For example, it appears that the Office Action suggests that an omitted step is “(e) processing the result of the calculation of the derivative product order based upon a function of the derivate risk data and the utilization data.” There is no antecedent basis in original claim 1 or the language in the Office Action for “the calculation of the derivative product order.”

The specification and figures provide detailed examples of the claim language provided above. See, for example, Figures 2-4 and pages 10-12 of the specification.

Applicants appreciate the Examiner’s consideration and suggestions on page 3 of the Office Action for possible claim amendments to obviate the rejection. However, as discussed during the interview, Applicants respectfully believe that making such amendments is not required by the prior art or 35 USC § 112, 2nd paragraph.

At the bottom of page 3, the Office Action indicates that “[o]nce the above issues have been resolved, an extensive search has been conducted on the claim amendments, and if no new art is found, the application should be in condition for allowance.” As explained above, Applicants submit that all issues are resolved. The claims are not being amended and the Applicant respectfully submits that the present application is in condition for allowance.

A Petition to Make Special was granted in this application over 2 years ago. Almost 9 months after the Petition was granted, the Office issued a Restriction. Applicants filed a

response in 4 days. Then, almost 9 months passed until an Office Action on the merits was issued. Applicants conducted an interview and filed a response within the 3 month period for response. The only prior art rejection that was made was subsequently withdrawn.

At the time of filing this paper, over two years have passed since the grant of the Petition to Make Special. During that time the Office has only issued one Office Action including a prior art rejection of the claims and, that rejection was withdrawn. In addition to responding to the prior art rejection, Applicants have conducted two telephone interviews and offered to travel to the Office to conduct a personal interview. Applicants would appreciate any guidance and/or suggestions that will help expedite the prosecution of this application.

CONCLUSION

Therefore, for at least this reason, Applicants respectfully request reconsideration and reversal of the rejection. All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5437.

Respectfully submitted,

Date: February 12, 2007

/Charles L. Miller/
Charles L. Miller
Registration No. 43,805
BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago, IL 60606-7407
Telephone: 312-463-5000
Facsimile: 312-463-5001

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 006119.00010	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number 10/676,318	Filed October 1, 2003
		First Named Inventor Johnston	
		Art Unit 3624	Examiner Colbert
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. 43,805 Registration number _____</p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></div><div style="width: 50%; text-align: center;"><p>_____ /Charles L. Miller/ Signature Charles L. Miller _____ Typed or printed name 312-463-5000 _____ Telephone number February 12, 2007 _____ Date</p></div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.